No. 79-136

In the Supreme Court of the United States

OCTOBER TERM, 1979

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS, PETITIONER

v.

MALCOLM E. BERGY, ET AL.

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS, PETITIONER

v.

ANANDA M. CHAKRABARTY

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

REPLY MEMORANDUM FOR THE PETITIONER

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1. Respondents contend that the decisions below did not extend the coverage of the patent laws because patents have previously been issued for living things (Bergy Op. 6-7; Chakrabarty Op. 8). But although such patents may occasionally have been granted,[1] those

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[1]Some of the patents cited by respondents and the Court of Customs and Patent Appeals claim a virus, which some scientists consider to be without life (Pet. App. 66a-67a, Nos. 5, 8). See Weaver, *The Cancer Puzzle*, 150 Nat'l Geographic 396, 397 (Sept. 1976); Gore, *The Awesome Worlds Within a Cell*, 150 Nat'l Geographic 355, 386 (Sept. 1976).

grants represent aberrations, rather than any settled agency interpretation of the patent laws. This Court has remarked on "the free rein often exercised by Examiners in their use of the concept of 'invention.' " *Graham* v. *John Deere Co.*, 383 U.S. 1, 18 (1966). This "free rein" is the inevitable result not only of the large number of patent applications processed each year by the patent examining corps,[2] but also of the patent statutes, which provide no procedure for administrative review of an examiner's decision to grant a patent. 35 U.S.C. 7, 131, 134; see *Watson* v. *Bruns*, 239 F. 2d 948 (D.C. Cir. 1956). For these reasons, isolated grants of patents by patent examiners are not entitled to the usual weight given to the administrative interpretation of a statute. *Andrews* v. *Hovey*, 124 U.S. 694, 716-718 (1888).

The Board of Appeals has consistently denied patents on claims drawn to living things themselves (see, in addition to the present cases, *In re Merat*, 519 F. 2d 1390, 1393 (CCPA 1975)). As noted in our petition, the issue is one of first impression in the courts (Pet. 8).

2. Respondent Chakrabarty also contends (Op. 10-12) that Congress found it necessary to pass the Plant Patent Act of 1930 not because plants as living things fell outside the scope of patentable subject matter but because plants were believed to be unpatentable as products of nature. He bases this argument primarily[3] on the assertion that

[2]The Patent and Trademark Office granted 70,320 patents in FY 1978. A staff of 1,064 professional employees worked there at that time, mostly in the patent examining corps. *Commissioner of Patents and Trademarks, Annual Report FY 1978* 12, 30 (1979).

[3]He also relies on *Ex Parte Latimer*, 1889 C. D. 123, and an article published in the *Journal of the Patent Office Society* in 1923 (Chakrabarty Op. 11-12). Whatever the positions adopted in those materials, there is no evidence that Congress was even aware of them, much less shared any views expressed therein.

the Commissioner of Patents made "very substantial objection" to the original plant patent legislation on the basis that plants were products of nature (Op. 12). The legislative history of the Plant Patent Act shows, however, that the Commissioner's objection was only to that part of the original bill which would have extended patent protection to already existing plants, not to the extension of such protection to plants created by botanists and horticulturists.[4] Thus, the Commissioner specifically

[4]The first Senate and House bills, which extended patent protection to "any person who invented or discovered * * * any new and distinct variety of asexually reproduced plant" both contained the following proviso:

> *Provided*, That the words "invented" and "discovered" * * * in regard to asexually reproduced plants, shall be interpreted to include invention and discovery in the sense of finding a thing already existing and reproducing the same as well as in the sense of creating. [S. 3530, 71st. Cong., 2d Sess. § 4886 (1930); H.R. 9765, 71st Cong., 2d Sess. § 4886 (1930) in R. Allyn, THE FIRST PLANT PATENTS 60 (1934).]

In a memorandum included in the record of the House hearings, the Commissioner of Patents distinguished between those varieties of plants found in nature and then asexually reproduced and those new varieties "created, for example, by cross pollination resulting from human efforts * * *." *Hearings on H.R. 11372 Before the House Comm. on Patents*, 71st Cong., 2d Sess. 6 (1930) (Memorandum of Commissioner Thomas E. Robertson). He had no objection to patenting plant varieties created by plant breeders, nurserymen and horticulturists since such varieties were not produced by natural processes. The Commissioner objected only to patenting those plant varieties "reproduced by operation of nature, aided only by the act of the patentee in grafting it by the usual methods * * *" (emphasis in original) (*ibid.*). He did not think such products of nature satisfied the constitutional requirement of invention (*ibid.*).

The language to which the Commissioner objected was not in the version of the bill reported out of committee. H.R. Rep. No. 1129, 71st Cong., 2d Sess. 11 (Appendix B) (1930); S. Rep. No. 315, 71st Cong., 2d Sess. 10 (Appendix B) (1930).

recognized that some plants are created by man, and are thus *not* products of nature. He nevertheless concluded that such plants were not then patentable; he agreed that the patent laws should be extended to make it possible to grant patents for such plants. *Hearings on H.R. 11372 Before the House Comm. on Patents,* 71st Cong., 2d Sess. 6 (1930) (Memorandum of Commissioner Thomas E. Robertson). The Commissioner's views therefore accorded with those of the Secretary of Agriculture, who told the congressional committees that the patent laws then covered "only inventions and discoveries in the field of inanimate nature." H.R. Rep. No. 1129, 71st Cong., 2d Sess. 10 (Appendix A) (1930); S. Rep. No. 315, 71st Cong., 2d Sess. 9 (Appendix A) (1930).[5]

For the reasons stated herein and in the petition, the petition for a writ of certiorari should be granted.

Respectfully submitted.

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Solicitor General

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[5]Respondent Chakrabarty discounts the views of the Secretary of Agriculture on the ground that he was "not shown to have any expertise in the patent law" and because his interpretation was "not shown to have had any impact on the Congress" (Op. 11). On the contrary, the Secretary's letter was appended to the Committee reports. H.R. Rep. No. 1129, 71st Cong., 2d Sess. 10 (Appendix A) (1930); S. Rep. No. 315, 71st Cong., 2d Sess. 9 (Appendix A) (1930). While the Secretary's views on the existing law's coverage were not discussed in the Committee reports themselves, both reports referred to his letter in connection with other matters. H.R. Rep. No. 1129, *supra*, at 3, 6; S. Rep. No. 316, *supra*, at 3, 5.

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